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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Yasuhiro Nakai

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EXAMINER

PILLAI, NAMITHA

ART UNIT

PAPER NUMBER

2173

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/833,651

**Applicant(s)**

NAKAI ET AL.

**Examiner**

NAMITHA PILLAI

**Art Unit**

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9 is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. The Examiner acknowledges Applicant's submission of the Appeal Brief filed on 11/6/08. In view of arguments against claim 1 including the feature of the print icon being generated, the prosecution has been re-opened. Claims 1-8 and 10-11 are rejected. Claim 9 is allowed.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No. 5,546,527 (Fitzpatrick et al.), herein referred to as Fitzpatrick and U. S. Patent No. 5,638,505 (Hemenway et al.), herein referred to as Hemenway and U. S. Patent No. 7,130,070 B2 (Evans et al.), herein referred to as Evans.

Referring to claim 1, Fitzpatrick discloses a print control operation system using icons including a display picture for displaying a print icon having predetermined print conditions and a file icon of a file to be printed, print processing of the file being executed under the predetermined print conditions in the print icon by dragging the file icon and dropping the file icon on the print icon (Figure 4 and column 1, lines 21-30). Fitzpatrick discloses that print icon is formed so that the display is altered to a setting of the print conditions, wherein the print icon is formed to have default print conditions

(column 1, lines 27-30). The print icon of Fitzpatrick limits on specific functions among print processing functions, where the print processing functions are the print processing parameters that are used to apply to the printer and print job (column 4, lines 1-4), with the print processing functions associated with a corresponding printer. Fitzpatrick discloses that the print icons represents specific functions related to print processing functions provided in a corresponding printer (column 1, lines 22-30), with the corresponding printer containing specific functions that are applied to the printing process of the file to be printed. Fitzpatrick discloses that the print command as a function is issued specifying the file icon for the printer when the file icon is dragged and dropped on the print icon (column 1, lines 22-30). The print command is issued specifying the file icon for the printer when the file icon is dragged and dropped on the print icon (column 1, lines 22-30). Fitzpatrick also discloses that the print icon is displayed and represented on the screen with designated functions that are frequently used, where the default print processing parameters represent the frequently used print processing functions that are applicable to a printer (column 1, lines 60-67). When going back to the default parameters of the print icon, this designates the default parameters which are the frequently used functions between the functions that the icon can represent. The default parameters are designated between the new parameters and the default parameters. Fitzpatrick also discloses the predetermined print conditions in the print icon being displayed on the display picture in a recognizable display form (Figure 4 and column 2, lines 11-13) but discloses that the print conditions are displayed by locating the file icon on the print icon. Hemenway carries out the same

methods as disclosed by Fitzpatrick of dragging and dropping a file icon on to a print icon in order to print the contents of the file icon (column 1, lines 65-67 and column 2, lines 1-5). Hemenway in addition to that, also displays the print conditions in a recognizable display form when the file icon is not located over the print icon, wherein this print information is always displayed (reference number 46, Figure 3A). It would have been obvious for one skilled in the art at the time of the invention to display the print conditions in a recognizable display form when the file icon is not located over the print icon. Hemenway and Fitzpatrick both teach printing files through icon manipulation, wherein a file icon is dragged and dropped onto a print icon in order for that distinct printer to print the file. Hemenway furthermore allows for the user to view the print conditions without an additional dragging process, wherein this convenient method can be beneficial in Fitzpatrick's disclosure, wherein the user can view the print conditions before dragging the file icon. Furthermore, Fitzpatrick teaches prior art and well known methods in the field of printer processing, wherein the user had access to a printer icon containing printer conditions, wherein a direct access of the user by clicking on this printer icon would allow for the print conditions to be displayed on the display picture in a recognizable display form when the file icon is not located over the print icon (column 1, lines 35-50). Hemenway further teaches the methods as discussed above.

Fitzpatrick and Hemenway do not disclose generating an icon. Evans discloses generating a print icon in response to changes in current conditions (column 10, lines 7-11). It would have been obvious to one skilled in the art at the time of the invention to learn from Evans generating an icon. Displaying an icon with distinct print conditions as

is disclosed in Fitzpatrick includes generating the icon for further display. In view of Fitzpatrick displaying the icon, generating the icon would be obvious. Therefore it would have been obvious to one skilled in the art at the time of the invention to learn from Evans generating an icon.

Referring to claim 2, Fitzpatrick discloses that at a time point when a file icon of a file to be printed is superposed on the print icon, an outline of the print conditions preset in the print icon are displayed on the display picture (Figure 4 and column 2, lines 32-37).

Referring to claim 10, Fitzpatrick discloses that a time point when a file icon of a file to be printed is superposed on the print icon, a printing preview of the file icon is displayed on the display picture, wherein the print parameters which apply to the file icon for printing inherently teaches a preview means for the previewing of the file icon (Figure 4), further as per the present claims, a preview is available of the file icon, wherein the file icon is displayed to the user when the file icon is superposed onto the printer icon as shown in Figure 3, wherein this display of the file icon allows the user to have a print preview of the file icon, wherein the file that is to be printed, is previewed, thus teaching a printing preview of the file icon.

3. Claims 3, 5-8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzpatrick and U. S. Patent No. 7,216,304 B1 (Gourdol et al.), herein referred to as Gourdol.

Referring to claim 3, Fitzpatrick discloses a print control operation system using icons including a display picture for displaying a print icon having predetermined print

conditions and a file icon of a file to be printed, print processing of the file being executed under the predetermined print conditions in the print icon by dragging the file icon and dropping the file icon on the print icon (Figure 4 and column 1, lines 21-30).

Fitzpatrick discloses that the print conditions in the print icon are displayed on the display picture in a recognizable display form (Figure 4 and column 2, lines 1 1-13).

Fitzpatrick discloses at a time point a file icon of a file to be printed is superposed on the print icon, a printing preview of the file icon is displayed on the display picture, wherein the print parameters which apply to the file icon for printing inherently teaches a preview means for the previewing of the file icon (Figure 4), further as per the present claims, a preview is available of the file icon, wherein the file icon is displayed to the user when the file icon is superposed onto the printer icon as shown in Figure 3, wherein this display of the file icon allows the user to have a print preview of the file icon, wherein the file that is to be printed, is previewed, thus teaching a printing preview of the file icon. Fitzpatrick disclose displaying a printing preview of the file icon but does not disclose providing preview data that displays what is contained within this file icon.

Gourdol discloses that in response to dragging and dropping a file document, a word processing application is opened to view the document thus providing a preview of the file icon that has been dragged (column 1, lines 46-53). It would have been obvious to one skilled in the art, at the time of the invention, to learn from Gourdol providing a preview of content of a file icon. Fitzpatrick has already disclosed providing a preview of print conditions associated with one of the icons, being the print icon without actually having to open the application in order to view the print data. Therefore, Fitzpatrick has

taught previewing of data associated with icons when a distinct icon is superposed over another icon. Gourdol provides preview of the document so that the user is able to first view a document before printing. This would provide the user of Fitzpatrick with the additional data that conveys exactly how the document will look when printed. With this teaching in Fitzpatrick and the user's desire to preview data to be printed, it would have been obvious for one skilled in the art at the time of the invention to apply the previewing of print conditions to those of the contents of the file icon. Therefore, it would have been obvious to one skilled in the art at the time of the invention to learn from Gourdol providing a preview of content of a file icon.

Referring to claim 5, Fitzpatrick discloses when a file icon of a file to be printed is dragged and dropped on the print icon, a window for setting print conditions of the print icon is opened (column 2, lines 47-50 and Figure 4).

Referring to claim 6, Fitzpatrick discloses when a file is dragged and dropped on the print icon, a printer capable of conducting print processing is automatically selected based on print conditions set in the print icon, wherein once the file icon is dropped onto a print icon, from within the parameters disclosed, the specific printer is determined (column 4, lines 1-4).

Referring to claim 7, Fitzpatrick discloses when a tile icon is dragged and dropped on the print icon, a printer capable of conducting a print processing is automatically selected from among printers in a stand-by state, based on print conditions set in the print icon (column 3, lines 58-60 and column 4, lines 1-4).

Referring to claim 8, Fitzpatrick discloses a printer to be used is set in the print icon as one of set conditions of the print icon (column 4, lines 1-4). Fitzpatrick discloses monitoring the target print icons to determine if the state of the printer is monitored such that the printer cannot execute processing set in the print icon, the print icon is controlled so as not to be displayed (column 6, lines 24-30), wherein Fitzpatrick teaches upon determining that the printer target is cannot do processing will ensure that the print icon is not to be displayed and not accessible for manipulation.

Referring to claim 11, Fitzpatrick discloses that the printing preview allows a user to view and confirm contents of a file to be printed without having to open the file on an application based on the combination presented for the rejection of claim 3, teaching that the information provided for previewing is done so without opening an application and where the display shows simply the items without any relation to a specific application under which the items have been accessed.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzpatrick, Gourdol and Hemenway.

Referring to claim 4, Fitzpatrick does not explicitly imply a plurality of file icons of files to be printed being dragged and dropped on the printer icon and further determining that the files are consecutively subject to print processing. Hemenway much like Fitzpatrick, allows for a drag and drop means for dragging file documents and dropping them onto print icons for printing to occur, wherein Hemenway goes further to display to teach that multiple print jobs are applicable to the one print icon (Figure 5C and column 11, lines 28-31), wherein printer Spitfire discloses having multiple files icons

to be printed. It would have been obvious for one skilled in the art, at the time of the invention to learn from Hemenway to implement a means for a plurality of file icons of files to be printed by dragging and dropping the files onto the print icon, the files being consecutively printed as a series of recorded matters. It is necessary to have a method for printing various documents, which is necessary for users of any computer system. Thus, as Hemenway teaches, the ability to drag and drop a plurality of documents on to the print source or icon allows for the print jobs to be queued to be processed consecutively, thus allowing for various documents to be printed at the same time.

#### ***Response to Arguments***

5. Applicant argues that Fitzpatrick and Hemenway do not disclose the print icon having the predetermined print conditions. The Examiner respectfully disagrees. The print icons in Fitzpatrick and Hemenway contain print conditions that are applied to a printed document. These icons represent print conditions that are accessible and applied to a document to be printed. A standard print icon displayed on a desktop **has** print conditions. Therefore, these print icons **have** predetermined print conditions. Applicant argues that the print conditions are not displayed on the print icons. This element has not been clearly disclosed in the present claims. Claims amended to clearly recite that the print conditions are **displayed on** the print icon would overcome the current rejection.

#### ***Conclusion***

6. Responses to this action should be submitted as per the options cited below: The United States Patent and Trademark Office requires most patent related

correspondence to be: a) faxed to the Central Fax number (571-273-8300) b) hand carried or delivered to the Customer Service Window (located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), c) mailed to the mailing address set forth in 37 CFR 1.1 (e.g., P.O. Box 1450, Alexandria, VA 22313-1450), or d) transmitted to the Office using the Office's Electronic Filing System.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namitha Pillai whose telephone number is (571) 272-4054. The examiner can normally be reached from 8:30 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, Kieu Vu can be reached on (571) 272-4057.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Namitha Pillai  
Patent Examiner  
Art Unit 2173  
February 2, 2009

/Namitha Pillai/

Primary Examiner, Art Unit 2173